

means for performing in-vehicle processing of signals to obtain a fix of vehicle

location:

*E3*  
*Conrad*

a paging request responder for receiving a paging request; and

a communications device for operation independent of the paging request responder

and responsive to the paging request for transmitting the fix to a designated service center.

#### REMARKS

Claims 1-59 are presented, namely original claims 1-27, copied without amendment from original letters patent No. 5,418,537, and claims 28-59, added in this reissue application.

In an Ex parte Quayle communication mailed July 15, 1999, the Examiner indicated that claims 1-49 were allowable.

In response to the Ex parte Quayle communication, applicant surrendered original letters patent No. 5,418,537 under cover of a communication mailed August 9, 1999.

In a new Office Action, claim 32 is now objected to for failure to meet the underlining requirements for reissue applications. Claim 32 is resubmitted with proper underlining (see 37 CFR 1.121(b) and 1.173 and MPEP §§ 1411 and 1453) but without further change.

Withdrawal of the objection to claim 32 stated in section 1 on pages 2 and 3 of the outstanding Office Action is respectfully requested.

Claim 28 has also been amended to rephrase a recitation therein (discussed below) to be consonant with language employed in certain other independent claims. Claim 33 has been amended to correct a clerical error. Amended claims 28 and 33 are properly underlined.

A new reissue declaration is submitted herewith in view of the amendment of claims

28 and 33 and the submission of new claims 50-59.

In the new Office Action, claims 1-49 are rejected on the ground that they allegedly recapture claimed subject matter deliberately canceled in application serial no. 07/978,272, which resulted in original letters patent no. 5,418,537. The Examiner states in particular that independent claims 28-33 of the present application recapture subject matter from canceled claim 31 in the '272 application.

The rejection is respectfully traversed.

It is understood from a telephone discussion of this case with the Examiner that the rejection of original claims 1-27 (as opposed to claims added in this application) is merely pro forma. That is, if the present application were abandoned, applicant's original patent No. 5,418,537 would be returned to the applicant, containing claims 1-27, which would remain in full force and effect and without any hiatus. (As indicated below, however, the surrender of the '537 patent was appropriate, and that patent should be replaced by a reissue patent based on the present application.)

The reason applicant traverses the rejection of claims 1-49 (and would traverse a corresponding rejection of claims 50-59) is that such a rejection is inconsistent with the facts of the prosecution history of the '537 patent and with the governing case law and MPEP § 1412.02, relating to recapture of canceled subject matter.

No claim of the scope of now-pending claims 28-59 was ever presented in the application resulting in the '537 patent. Applicant never canceled or surrendered claims having the scope of claims 28-59, and recapture is therefore not possible.

Under In re Clement, 131 F.3d 1464, 45 USPQ 2d 1161 (Fed. Cir. 1997), cited at

MPEP § 1412.02, if a reissue claim is narrower than claims canceled from the application leading to the original patent in an aspect germane to a prior art rejection, the recapture rule does not bar the claim, even if the reissue claim is broader in a different aspect.

After summarizing the governing law as represented by Clement and the cases cited in the Office Action, MPEP § 1412.02 states the position of the Patent Office. In the following quotation stating the PTO's position, we have added the parenthetical numbers "(1)", "(2)" and "(3)" and the underlining, and have copied one sentence in boldface type.

Impermissible recapture occurs in a reissue where the claims in the reissue are (1) of the same scope as, or are (2) broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. **If the narrowing limitation has a material aspect to it, then there is no recapture.** However, if the narrowing limitation is (3) incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17.

Thus under MPEP § 1412.02 there are three, and only three, circumstances under which there is impermissible recapture. Those circumstances, which are numbered and underlined in the passage quoted above, are the following:

(1) First Circumstance

Recapture arises when the claims of the reissue application are of the same scope as claims deliberately canceled from the application to obtain the original patent.

That circumstance does not apply here. Claims 1-27, copied verbatim from the '537 patent, were obviously not canceled from the application resulting in the '537 patent, and claims 28-59 appear for the first time in this reissue application. Neither claims 28-59 nor

claims having a scope equal thereto were ever presented in, or canceled from, the application resulting in the '537 patent.

(2) Second Circumstance

Recapture arises when the claims of the reissue application are broader in every aspect than claims deliberately canceled from the application to obtain the original patent.

That circumstance does not apply here. As indicated above, claims 1-27 are copied from the original '537 patent. As indicated below, claims 28-59 are broader in some aspects and narrower in others than claims canceled from the application resulting in the '537 patent. It is elementary that if one claim recites features ABC and another recites features BCD, neither claim contains the other; their relation is that of a Venn diagram containing two circles that intersect, each circle lying partly outside the intersection. It cannot validly be asserted that claims 28-59 are broader than claims deliberately canceled from the application resulting in the '537 patent.

(3) Third circumstance

Recapture is impermissible when the narrowing limitation in the claims of the reissue application is incidental, mere verbiage, or would be inherent even if not recited.

That circumstance, the third and final one for applying the recapture doctrine under MPEP § 1412.02, does not apply here.

In the outstanding Office action, the Examiner states that claims 28-33 in the present application recapture subject matter from canceled claim 31 in application serial No. 07/978,272. However, each of independent claims 28-33 added in the present application calls for a paging request responder and a communications device separate from, and for

operation independent of the paging request responder, or a method employing such devices (see claim 28 as amended and the similar recitations in claims 29-33). New claims 50-59 specify either that feature or a noncellular paging request responder and a cellular communications device or a method employing such devices, or the feature that the communications device is for operation independent of the paging request responder or a method employing such a communications device. Neither claim 31 nor any other claim canceled from application serial No. 07/978,272 contains such limitations.

Those features of the invention are not "incidental", "mere verbiage", or "inherent even if not recited".

If "separate" and "independent" feature of the invention were "incidental" or "mere verbiage", its insertion into the independent claims would not have led to their allowance in the Ex parte Quayle action. The "cellular" and "noncellular" feature is also neither incidental nor mere verbiage. Nor is it "inherent even if not recited" that the communications device be separate from, and for operation independent of, the paging request responder. Both devices can easily in principle be incorporated into a single unit (as opposed to being provided as separate units) wherein neither device is for operation independent of the other. Finally, the "cellular" and "noncellular" feature and the independent operation feature are clearly not inherent.

Besides describing the three circumstances discussed above under which the recapture doctrine applies, not one of which circumstances applies here, MPEP § 1412.02 contains the following guidance:

**"If the narrowing limitation has a material aspect to it, then there is no recapture."**

As indicated above, the aspects of the invention considered above are ones in which all of the reissue claims are narrower than all of the claims canceled from the application resulting in the original '537 patent. The question for the Examiner to resolve, therefore, is whether those narrowing limitations have "a material aspect" to them. Unquestionably they have.

The allowance of claims 28-49 in the Ex parte Quayle communication is an acknowledgment by the PTO that the "separate" and "independent" feature has a material aspect to it. It is submitted that the "independent" feature by itself is also material.

The "cellular" and "noncellular" feature, in combination with the other features of the claims reciting it, defines subject matter that is neither disclosed nor suggested by the prior art. In particular, the Song patent No. 5,208,756 discloses that the activation signal for the vehicle locating transceiver 19 is transmitted to the transceiver over the cellular telephone network (col. 8, lines 3-5). The novel "cellular" and "noncellular" feature recited in certain of the reissue claims therefore also has a material aspect to it.

Since those characterizations did not appear in any claims of the application resulting in the '537 patent, there is no recapture here.

For the reasons stated, it is respectfully requested that the objection and rejection stated in the outstanding Office Action be withdrawn, and that the Examiner issue a Notice of Allowance.

Respectfully submitted,  
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